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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/602,416	06/23/2003	Scott Seamans	40130-050010	9598
20350	7590	01/09/2006	EXAMINER	
TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			MOHANDESI, JILA M	
		ART UNIT	PAPER NUMBER	
		3728		

DATE MAILED: 01/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/602,416	SEAMANS, SCOTT
	<b>Examiner</b>	<b>Art Unit</b>
	Jila M. Mohandes	3728

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 02 December 2005.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1,9,12-16,18-27 and 40-42 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1,9,12-16,18-27 and 40-42 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 11-28-05 & 12-02-05
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_.

**DETAILED ACTION**

***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on December 02, 2005 has been entered.

***Response to Amendment***

2. The proposed reply filed on December 02, 2005 indicates that a new claim 43 was added to the claims. There was no new claim 43 provided with the amendment.

***Information Disclosure Statement***

3. The submission of some of the Non Patent Literature Documents disclosed on the information disclosure statement filed December 02, 2006 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because Non Patent Literature Documents BCC, BDD, CA, CB, CC, CD and CF are not prior art documents. It has been placed in the application file, but the information referred to therein with respect to the Non Patent Literature Documents BCC, BDD, CA, CB, CC, CD and CF has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the

statement, including all certification requirements for statements under 37 CFR 1.97(e).

See MPEP § 609.05(a).

4. When submitting a new IDS, only cite new references on the IDS to be considered. Do not repeat and list the previously cited and considered references for ease of consideration.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. Claims 1, 9, 12-16, 18-23, 26-27 and 40-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aguerre (6,237,249) in view of Seidel et al. (4,476,600), the admitted prior art on page 11 of the instant specification and Albiniano (2,897,566). Aguerre '249 discloses a breathable footwear (ventilation holes 130) with a sole

comprising an outer portion of a rear sole perimeter, a bottom surface and a support base , and wherein the support base includes a raised pattern where the foot contacts the support base to provide support to the heel of the wearer and helps maintain the footwear in position. Aguerre '249 also discloses the breathable footwear to include a strap pivotable attached by a plastic rivet at opposite ends thereof to the base section for securing the footwear on the foot of the wearer. Aguerre '249 does not disclose the upper and sole section being formed from a piece of lofted foam material and for the strap to made of foam and it is also silent as whether the pivotable strap contacts the outer portion of the rear sole perimeter. Seidel '600 discloses a breathable footwear piece with ventilation holes, the breathable footwear piece comprising: a base section, wherein the base section includes an upper and a sole formed as a single part molded from a first continuous piece of expandable foam material. See Figures 1 and 6 embodiments. Albiniano '566 discloses that it is desirable to have the strap also swivel/pivot towards the back of the shoe and maintained on the rear sole perimeter to allow the shoe to be worn without the strap in different arrangement to give the wearer different design options.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the upper and sole of Aguerre '249 from a piece of expanded foam material and the strap from expanded foam material as taught by Seidel '600 for easier and cheaper manufacturing of the footwear.

With respect to the expandable foam material of Seidel '600 being lofted foam material , the admitted prior art in the instant specification discloses that it is desirable to

manufacture footwear from an expandable EVA known commercially as LEVIREX which is considered to be a lofted foam material which can exhibit a final growth value of between 1.47 and 1.58. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the modified footwear of Seidel '600 from lofted foam material as taught by the admitted prior art in the instant specification to provide a relatively soft footwear piece that has very good anti-slip capabilities, and at the same time, size reproducibility and durability.

Also it would have been obvious to one of ordinary skill in the art at the time the invention was made to also have the strap of Aguerre '249 swivel to the back of the shoe and contact the outer portion of the rear sole perimeter and be maintained fixed relative to the base section as taught by Abiniano '566 to allow the shoe to be worn without the strap in different arrangement to give the wearer different design options.

With respect to claim 24, see Figures 1 and 2 of Aguerre '249, which includes both toe, and heel raised sections for better supporting the foot.

With respect to claims 20-22, Seidel '600 discloses an upper that includes a substantially vertical region, where the vertical region includes a toe region and opposing side regions, and wherein the toe region is solid portion, and wherein at least some of the plurality of ventilators are formed in the side regions. Aguerre '249 discloses a toe region that clearly follows the contour of a human foot. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the toe region of the upper of Aguerre '249 extend at a location

corresponding to the larger toes of the human foot as taught by Seidel '600 to provide better protections to the toes of the wearer.

The product-by-process limitation in claim 26 results in no structure that is different from Seidel '600 as modified above.

9. Claims 24 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over the above references as applied to claim 1 above, and further in view of Lamstein (Des. 416,667). Aguerre '249 as modified above discloses all the limitations of the claims except for the support base including raised pattern extending throughout the surface and for the bottom surface of the sole having front and rear tread patterns longitudinally connected by a flat section. Lamstein discloses a molded footwear with the support base including raised pattern extending throughout the surface and with the bottom surface of the sole having front and rear tread patterns longitudinally connected by a flat section. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the support base with raised pattern extending throughout the surface of the footwear of Aguerre '249 as taught by Lamstein for better massaging the foot and for the bottom surface of the sole having front and rear tread patterns longitudinally connected by a flat section for easier manufacturing as taught by Lamstein.

#### ***Response to Arguments***

10. Applicant's arguments filed December 02, 2005 have been fully considered but they are not persuasive.

In response to applicant's argument that there is no motivation to substitute the washers of Aguerre with the connectors of Albimiano, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, to make the

upper and sole of Aguerre '249 from a piece of expanded foam material and the strap from expanded foam material as taught by Seidel '600 for easier and cheaper manufacturing of the footwear.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

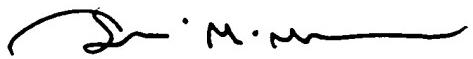
### ***Conclusion***

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jila M. Mohandesu whose telephone number is (571) 272-4558. The examiner can normally be reached on Monday-Friday 7:30-4:00 (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (571) 272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Art Unit: 3728



Jila M Mohandes  
Primary Examiner  
Art Unit 3728

JMM  
January 05, 2006